(2)

Supreme Court, U.S.
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No. 97-717

In The

Supreme Court of the United States

October Term, 1997

TRINITY INDUSTRIES, INC.,

Petitioner,

vs.

JOHNSTOWN AMERICA CORPORATION and JAC PATENT CORPORATION,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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37pp

QUESTION PRESENTED

When an accused infringer in a patent suit in a federal district court files a declaratory judgment counterclaim to have the patent in suit held invalid and not infringed and files a cross-appeal to the Federal Circuit Court of Appeals from a special jury verdict and judgments that the patent is not invalid and not infringed and then causes such appeal to be dismissed after briefing the issues for review and excludes the invalidity issue, is the party entitled to a remand and retrial of its invalidity defense following an adverse judgment by the appeals court holding the patent infringed and the issue of invalidity waived?

PARTIES TO THE PROCEEDINGS

Petitioner accurately lists the parties to the proceeding.

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OPINIONS BELOW AND JURISDICTION

Respondents are satisfied with Petitioner's presentation of the opinion below and grounds on which it seeks to invoke the jurisdiction of this Court.

STATEMENT OF THE CASE

A. The Petition Fails To Disclose A Critical Fact: Petitioner Cross-Appealed And Dismissed The Appeal.

Hereinafter, Respondents Johnstown America Corporation and JAC Patent Corporation are referred to collectively as JAC.

This is a patent case for alleged infringement where the Petitioner Trinity Industries, Inc. (Trinity), the defendant/appellee and accused patent infringer, defended the charge of infringement in the district court by denying infringement and alleging the patent invalid.[1] In fact, Trinity filed a declaratory judgment counterclaim to have the patent declared invalid under 35 U.S.C. §§ 102 and 103 as well as not infringed (R. 134a).[2]

In error, the district court in preliminary proceedings entered summary judgment in favor of Trinity on one issue. The district court held that Trinity's accused rotary gondola railroad car,

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1. Trinity also alleged the patent did not meet the requirements of 35 U.S.C. § 112(4); there was a misjoinder of an alleged inventor and a failure to comply with the conditions of patentability. File wrapper estoppel and inequitable conduct also were alleged.

2. Hereinafter, record citations in this response appear as follows:

(R.134a) Joint Appendix to Federal Circuit
(App. 1) Appendix to Petition
(JAC App.) Appendix to this Brief

the Aluminator II, did not literally infringe the patent. The issue of infringement under the doctrine of equivalents and Trinity's counterclaim and the defensive issue of invalidity were later submitted to the jury for special findings (R. 503a; JAC App. A). The jury was required, *inter alia*, to answer the following question:

> Do you find that Trinity has proven by clear and convincing evidence that the '097 patent is invalid?

The jury answered that question no. The jury also found the patent not infringed and judgments were separately entered in accordance with that verdict and also in favor of Trinity (App. 33), the latter because the jury found the patent not infringed (JAC App. A). JAC appealed (R. 514a) and Trinity cross-appealed (R. 516a; JAC App. B).

In its petition for a writ, Trinity intentionally omits the fact that it cross-appealed. And further, that during the proceedings in the Federal Circuit, Trinity moved for the dismissal of its appeal (JAC App. C). In response, the appeals court granted Trinity's request (JAC App. D).

Following oral argument the Federal Circuit rendered an unpublished, nonprecedential decision in favor of JAC that as a matter of law there was literal infringement, reversing the district court's summary judgment on that issue. The decision turned on the application of the definition of "longitudinal axis," as those words appear in the claims. The construction of Trinity's Aluminator II railroad car was indisputable. When the definition is applied, the axis of the Aluminator II troughs is parallel to the axis of the center sill and corresponds to the limitation of the claims and there is literal infringement.

In the district court, JAC had opposed summary judgment

on different grounds including those held to control by the appeals court. JAC argued, *inter alia*, that as a matter of law there was literal infringement.

In the appeals court, to defend the charge of infringement, Trinity argued non-infringement but did not argue that the patent was invalid as a matter of law and therefore not infringed, or that the jury verdict in favor of JAC on that issue should be vacated and a new trial granted.

The Federal Circuit remanded the case for a determination of damages and whether or not Trinity's infringement was willful as JAC also contended (*see* Charge to Jury; R. 1342a). Trinity's Aluminator II railroad car is essentially a copy of JAC's commercial embodiment of the claimed invention and in large part the work of a former employee of the original owner of the patent.

Trinity petitioned the Federal Circuit for rehearing with a suggestion for rehearing *in banc*, requesting a retrial of both issues — infringement and invalidity.[3] In its petition for rehearing, Trinity made various representations of fact concerning prior matters in the district court, particularly that Trinity tried its invalidity defense using the district court's construction of the parallelism limitation in the claims and that the jury's validity finding must have been based on that claim construction. Trinity went on to state further,

> Despite Trinity's disagreement with the district court's instruction in this regard, there was (at that time) no apparent reason for Trinity to appeal the jury's finding

3. Trinity disputed that its railroad car troughs were curved; also, that there were a pair of troughs. Trinity argued it had four troughs. However, based on Trinity engineering drawings, other evidence and admissions, the construction of the car was indisputable. *See* App. 37.

that the '097 patent was not invalid because judgment was entered in Trinity's favor.

Trinity in its petition for rehearing glossed over the fact that the district court also entered a separate judgment in accordance with the jury verdict, in essence, in favor of JAC and against Trinity on its counterclaim that the patent was invalid (JAC App. A). No other interpretation of that judgment would be reasonable in light of the special interrogatories answered by the jury, Trinity's counterclaim and judgment on the verdict.

JAC disputed the representations made by Trinity to the Federal Circuit. JAC moved to supplement the record and permission to do so was granted. Trinity also supplemented the record. In response to the petition for rehearing, JAC contended there were four reasons why rehearing should be denied, any one of which was sufficient to reject Trinity's argument. First, Trinity misinterpreted the law on the issue as it related to the case. Second, the claim construction determined by the Federal Circuit was precisely the construction argued by JAC since the beginning of the case. Third, construction of the parallelism claim limitation was and is irrelevant and immaterial to Trinity's invalidity defense and, fourth, Trinity waived its appeal as to the jury verdict in favor of JAC.

Trinity cross-appealed but it did not specify or brief the issue of alleged invalidity and then it dismissed its cross appeal (JAC App. B; JAC App. C) and never argued the issue. JAC contended Trinity abandoned and waived all of the issues appealed or that could have been appealed. The Federal Circuit was required to review the record and answer the question: Why did Trinity cross-appeal if it was satisfied with the judgments of the district court? The jury's finding that the patent was not invalid went directly to Trinity's counterclaim. Did losing on its counterclaim make Trinity happy?

After considering the contentions of the parties for and against rehearing and the record of the proceedings in the district court, the panel declined Trinity's request for rehearing and rendered a decision. The panel briefly noted the existence of a factual dispute (App. 39) and decided that Trinity had waived the specific issue of invalidity for which it sought a retrial by remand (App. 40). The suggestion for a rehearing *in banc* was declined by the court and the court issued its mandate. The decisions are unpublished.

There are other purported statements of fact in the petition with regard to Trinity's Aluminator II, the prior art and related matters with which JAC disagrees. However, a more detailed and lengthy reply is not believed necessary in light of the question and the undeniable fact that Trinity filed a cross-appeal, failed to brief or argue the issue of alleged patent invalidity and then dismissed its appeal.

REASONS FOR DENYING THE WRIT

I.

JAC RESPECTFULLY SUBMITS THAT TRINITY'S WRIT SHOULD BE DENIED AND THAT ANY OF THE FOLLOWING REASONS FOR DENIAL ARE SUFFICIENT TO CONCLUDE THAT DENIAL OF THE PETITION IS WARRANTED.

A. The Petitioner Intentionally Omitted A Material Fact Relating Directly To The Issue In Question.

The statement at page 7 of the petition that, "The Federal Circuit held that Trinity, as appellee, waived the affirmative defense of patent invalidity by failing to file a conditional cross-appeal" is completely without support in the record. That is not

what the court held. As explained in Respondents' statement of the case and verified by the record (App. 40), Trinity, dissatisfied in part with the result in the district court, filed an unconditional cross-appeal but then dismissed such appeal (JAC App. C) without briefing the issue of alleged invalidity. Undoubtedly Trinity concluded that to go forward with its appeal would have been fruitless or frivolous, and decided as a strategic matter to waive it. In its petition, Trinity has intentionally omitted a material fact relating directly to the issue in question by failing to disclose that it filed a cross-appeal and then requested that it be dismissed. Following trial in the district court, Trinity chose what issues to appeal and what issues to waive and the alleged need to file a conditional cross-appeal was never a factor because Trinity filed an unconditional appeal. This lack of candor is one of many examples of Trinity's lack of good faith in this litigation which began in 1992.

This is simply not a case worthy of review. Review of a case in which the petitioner filed a cross-appeal, failed to brief the invalidity issue for which it now seeks remand and then caused the appeal to be dismissed is not worthy of further consideration by this Court. And, further, it would be a gross injustice to JAC having been in this litigation since 1992 and having received a favorable jury verdict upholding the validity of the patent to now have the case remanded to the district court for a retrial. In Trinity's petition for rehearing, it could not point the Federal Circuit to any specific alleged error by the jury in upholding the validity of the patent, or any prior art evidence that would invalidate the patent. Trinity could only make vague assertions of alleged broadening of the claims by the Federal Circuit and alleged unfairness to Trinity as grounds for a retrial (JAC App. E). Review by this Court would unsettle a well established practice and procedure with regard to patent cases and encourage unjustifiable, frivolous petitions to this Court. Parenthetically, Trinity also attempted to delay issuance of the

Federal Circuit's mandate by similar tactics and in the district court following remand, the grant of an injunction to stop Trinity's infringement.

B. The Federal Circuit's Decision Not To Remand For A New Trial With Regard To The Defense Of Invalidity Is Not In Conflict With Any Decision Of This Court Or Any Decision of Another Circuit.

Trinity, at page 9, asserts that a writ should be granted citing, *inter alia*, *Cardinal Chemical Co. v. Morton Intern., Inc.*, 508 U.S. 83, 93, 124 L. Ed. 1 (1993) a patent case in support of its assertion that the practice followed by the Federal Circuit in this case, "conflicts in principle with prior decisions of this court." However, when the record is reviewed and the facts ascertained, there is no conflict.

Cardinal Chemical Co. v. Morton Intern., Inc., 508 U.S. 83, 89 (1993) concerns a different situation entirely. In that case the patent was held invalid in the district court and under prior practice such holding was rendered moot by the Federal Circuit if on appeal the patent was held not infringed. The holding in *Cardinal* changed the practice of mooting a holding that the patent was invalid. *Cardinal* does not suggest that where patent validity is upheld in the trial court that the validity must nonetheless be reviewed by the appeals court whether or not an appeal is taken, or remanded for a second trial in the event a finding of non-infringement is reversed on appeal. *Cardinal* was directed to the Federal Circuit's practice with regard to mooting a finding of invalidity and has no bearing on this case. A patent is presumed to be valid and when validity is upheld in a district court there is no public interest to consider as a basis for review by the Federal Circuit or this court when no appeal is taken from the district court or an appeal is dismissed.

The only other patent case cited in support of Trinity's theory is *Stelos Co. v. Hosiery Motor-Mend Corp.*, 295 U.S. 237 (1935). In that case, the district court held the only claim in issue was invalid but in the alternative, if valid, not infringed and dismissed the case. Stelos, the patentee, appealed. The appeals court affirmed the holding of non-infringement. However, the circuit also held the claim was valid. This Court granted a writ because of a conflict with another circuit and to conclude that the patent claim was invalid. This Court held the appellee could urge invalidity of the patent without applying for and obtaining a cross-writ although a writ was granted. The Federal Circuit ruling in the instant case presents no conflict with that holding.

Trinity's other citations are no better. Trinity attempts to compare patent infringement cases with their distinct, critical issues that are almost always present with a hodge-podge of cases factually and procedurally distinct that do not hold, teach or suggest that in this case a remand is required. At the very best, they teach that in some situations an argument may be made in an appeals court with regard to an issue without the need to take a cross-appeal or an appeal from the original tribunal. However, that is not the relief that Trinity sought in the Federal Circuit or seeks here. Trinity filed a declaratory judgment counterclaim in the district court and the judgment on the jury verdict that the patent was valid was clearly adverse to Trinity. Trinity appealed and then dismissed its appeal in the face of a clear rule but might nonetheless have argued that the Federal Circuit should consider patent validity, and whether or not the jury verdict was against the weight of the evidence or that Trinity was entitled to JMOL or a new trial; however, Trinity made no effort to do so and can point to no failure of the Federal Circuit to entertain such argument. What Trinity wants from this Court is to avoid a review of the jury verdict by the Federal Circuit and to start over with a new jury in the district court.

None of the cases that Trinity cites holds or even suggests that Trinity be granted such extraordinary relief particularly when JAC's Seventh Amendment rights are directly involved and could be negated.

C. Patent Cases Raise Issues Distinct From Non-Patent Cases And The Federal Circuit Has The Authority To Establish Patent Practice And Procedural Rules, Such As Whether Cross-Appeals Are Required Regarding Challenges To Patent Validity.

Infringement litigation has distinct issues that typically appear in almost all suits for infringement of a patent. The issues of infringement and invalidity are distinct from non-patent cases and the practice and procedure before the Federal Circuit, unless in direct conflict with this Court, should be a matter best left with the Federal Circuit. A charge of infringement may be defended on the ground of non-infringement alone or invalidity of the patent alone or on both grounds. An invalid patent cannot be infringed and when the presumed validity is challenged, validity remains relevant unless waived by the party challenging validity. If the challenge to validity is waived, that is the end of the issue and forecloses further consideration of the matter because there is no dispute to be resolved.

To assure a degree of fairness to the patentee, if validity is challenged the patentee is entitled to know the evidence to be relied upon prior to trial. 35 U.S.C. § 282 requires the accused infringer to give notice within 30 days of trial of all prior art to be relied upon to prove invalidity. Unless the Patent and Trademark Office (PTO) overlooked more pertinent prior art than it cited when granting the patent, a § 282 notice may bring forth nothing more material than the most pertinent references previously cited by the PTO. Here, for example, in 1978 the PTO considered the significance of the '660 Kuehner patent for

curved hopper chutes to which Trinity refers at page 3 and elsewhere in its Petition, many years before the district court heard the case and considered the scope of claims. In such examination the PTO was required by its rules to give the requested claims their broadest possible interpretation when searching for relevant prior art. And, after considering the '660 patent, following an original rejection of the claims,[4] the PTO was satisfied that the '660 patent did not render the claimed inventions of the application unpatentable and cited the '660 as a reference.

Prior to trial in the district court, Trinity contended the '097 patent was invalid as a matter of law and filed a Motion for Leave to File Summary Judgment of Invalidity, but it was denied as untimely (Order, September 14, 1995; *see* Docket at R. 115a). Trinity put the same evidence before the jury at trial. The decision of the jury was adverse to Trinity. The jury rendered its verdict that the patent was not invalid despite the '660 patent and all of Trinity's other evidence (JAC App. A). Trinity was rearguing past history with regard to the '660 patent but nonetheless Trinity had the opportunity to seek relief from the jury's verdict in the appeals courts if dissatisfied but it did not do so.

In a patent case, nothing is more fundamental and critical to an accused infringer than the defense of invalidity if there is substantial evidence to support such contention. An adverse result in the district court is always appealed as a matter of course unless to do so would be frivolous. That this is so has been crystal clear to patent law practitioners since at least the Federal Circuit's decision in *Radio Steel & Mfg. Co. v. MTD Products*, 731 F.2d 840 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 831, 83 L.

4. In the first examination of an application frequently the claims are rejected but then following the applicant's response, the examiner upon reconsideration will change his position. The practice is common.

Ed. 2d 62 (1984). Since that decision, there can be no argument that an accused infringer must cross-appeal or, if appropriate, brief the alleged invalidity issue. Otherwise the right to raise the issue is waived. The conservative practice is to appeal and brief the issue unless to do so would be frivolous. The result of requiring a cross-appeal assures that objections to the conduct or result of the trial in the district court are considered and decided in an orderly manner at the earliest opportunity and minimizes possible protracted and repetitive proceedings that otherwise could follow and would be unfair.

D. In Addition To Waiving The Validity Issue, Trinity's Argument For A Remand Has No Merit Because Its Invalidity Defense Had Nothing To Do With The Construction Of Claims By The Federal Circuit.

The district court's summary judgment decision did not affect the admissibility of Trinity's invalidity evidence or argument with regard to the alleged invalidity of the patent. In asserting the defense in the district court that JAC's patent was invalid under 35 U.S.C. §§ 102 and 103, Trinity did not rely on or even use the definitions of "longitudinal axis" or "axis" adopted by the district court. The district court's definition of "axis" which it applied to Trinity's troughs worked against JAC, not Trinity, and limited JAC's argument to the jury with regard to the doctrine of equivalents.

With regard to the alleged invalidity of the patent, in asserting a § 102 defense, the infringer must prove by clear and convincing evidence that every feature of the claimed invention, either explicitly or inherently is disclosed in a single prior art reference. In a § 103 defense, the infringer must prove by clear and convincing evidence that the invention as claimed was obvious to persons of ordinary skill in the art at the time of the invention. Obviousness may be proved by combining prior art

references or by other evidence, for example, non-patented art such as the Pullman car to which the petition refers. The Court of Appeals reviews a § 102 anticipation defense under the clearly erroneous standard. 35 U.S.C.A. § 102(d) — *In re Graves*, 69 F.3d 1147 (Fed. Cir. 1995), *reh'g denied, in banc suggestion declined, certiorari denied, Graves v. U.S. Court of Appeals for Federal Circuit*, 116 S. Ct. 1362, 134 L. Ed. 2d 528. The conclusion of obviousness is reviewed *de novo* as a matter of law, but determination of obviousness is based on factual inquiries which are reviewed under the clearly erroneous standard. 35 U.S.C.A. § 103; Fed. R. Civ. P. Rule 52(a), 28 U.S.C.A. — *B.F. Goodrich Co. v. Aircraft Braking Systems Corp.*, 72 F.3d 1577 (Fed. Cir. 1996).

Prior to trial, in accordance with the requirements of 35 U.S.C. § 282, Trinity identified about 130 patents and other documents to prove invalidity. At trial, Trinity's evidence was contradicted and discredited. The jury resolved the dispute in favor of JAC and upheld the validity of the patent.

The thrust of Trinity's invalidity defense at trial was based on prior art patents, including the '660 patent to which it refers in the petition. Trinity also argued that employees of Pullman rather than the named inventors of the '097 patent, were the first to conceive and reduce the invention to practice. The credibility of Trinity's evidence was argued to the jury and implicitly the jury resolved the ultimate issue against Trinity.[5]

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5. An application for a patent filed by Pullman was in an interference proceeding in the Patent and Trademark Office (PTO) with the '097 patent. Before the contest was concluded, Trinity succeeded to the rights of Pullman. Then Pullman or Trinity abandoned the issue, but nonetheless the district court permitted Trinity to retry the issue. JAC contended the issue was *res judicata* and Trinity's evidence inadmissible but the objection was overruled. JAC also had other objections to the conduct of the trial that were overruled.

Trinity filed a cross-appeal but did not specify the issue of patent invalidity. Faced with a credibility issue and substantial evidence to support the verdict, an appeal would have been frivolous. But now that infringement has been decided against Trinity, it is another story — according to Trinity. Trinity would like to bypass a review of the issue by the Federal Circuit on the merits of its invalidity evidence and instead return to the district court for a new trial on the same issue. To do so would be grossly unfair. Trinity's appeal was dismissed at Trinity's request and for that reason the Federal Circuit had no cause to review the evidence considered by the jury or to pass on legal issues, or to remand for a retrial of the very same issue.

In its petition for rehearing Trinity could point to no error on the part of the jury upholding the validity of the patent or any prior art reference or references that would invalidate the patent as a matter of law or specifically how the evidence on a retrial would differ at a new trial. Trinity's petition for rehearing did not mention one of the cited 130 prior art references that would arguably render JAC's '097 patent invalid as anticipated or obvious.

The unfairness to JAC should be obvious. A retrial deprives JAC of a jury verdict won in a hard fought contest. Trinity chose what issues to appeal and what issues to waive. Here, without grounds to obtain a reversal in the appeals court, Trinity would have this Court grant a retrial in the district court on a technical basis and bypass an orderly appeal process that Trinity invoked but then abandoned. If fairness to JAC means anything, Trinity's petition should be denied.

E. The Federal Circuit's Claim Construction Was The Same That JAC Urged In The District Court; Hence, Remand By The Federal Circuit Would Be Inappropriate Because Trinity Should Have Anticipated The Federal Circuit's Holding.

Trinity's post-judgment contention that a new trial should be granted because the appeals court broadened the scope of claims is both inaccurate and misleading. The Federal Circuit's claim interpretation is based on the definition of "longitudinal axis" and its application to the Aluminator II. The definition did not broaden any claims. The definition of longitudinal axis that the district court recognized but refused to apply was as follows:

> the straight line running lengthwise through the centers of the cross sections at the ends of the trough

(App. 18). The Federal Circuit definition was as follows:

> [a]n axis along the lengthwise direction of the figure or body, usually passing through its center of gravity

(App. 6). The above definitions are virtually identical and when applied to the Aluminator II railroad car both definitions satisfy the claim limitation and establish literal infringement.

CONCLUSION

Surely, there is no issue of national importance in this case. The practice and procedure to follow in patent cases both in district courts and the Federal Circuit is and has been well settled and should not be unsettled or altered as Trinity would have this Court believe. Practice in other types of cases in other circuits is irrelevant and immaterial because of the Federal Circuit's exclusive appellate jurisdiction with regard to patent

infringement suits. When an accused infringer raises the defense of patent invalidity, such person has the burden of proof to overcome the presumption of validity that attaches to the patent. If the accused infringer is dissatisfied with the result reached in the district court, such person may appeal unless satisfied that to do so would be frivolous. The time and place to make that decision and raise the issue is immediately following the decision in the district court and not after an appeal, cross-appeal and the appeals court's judgment.

Trinity's contention that until the appeals court reversed the district court it had no reason to be dissatisfied is utter nonsense. It lost on a critical issue in the district court and was always at risk that what happened could happen. Now, begging for another chance, Trinity not only attempts to create an issue from whole cloth with reference to conditional cross-appeals when that issue was never before the Federal Circuit, but in doing so, it intentionally omitted to disclose that it cross-appealed and waived its appeal.

REQUEST FOR SANCTIONS

As a result of (1) Trinity's lack of candor to this Court by its intentional omission of a material fact (its cross-appeal and waiver thereof) which relates directly to the issue in question and (2) the general lack of merit of Trinity's Petition, JAC hereby requests that the Court impose sanctions against Trinity under Section 42.2 of the Rules of the Supreme Court, which sanctions are requested to include, without limitation, double costs of JAC's responding to Trinity's petition. JAC acknowledges that this Court's policy has been to limit sanctions to egregious cases, but respectfully submits that Trinity's lack of good faith and candor in its petition makes this case an egregious case worthy of sanctions against Trinity.

Respectfully submitted,

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APPENDIX A — JUDGMENT AND VERDICT SLIP OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA DATED AUGUST 15, 1996

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF PENNSYLVANIA

CASE NUMBER: Civil Action No. 92-587-J

JOHNSTOWN AMERICA CORPORATION, and JAC PATENT CORPORATION,

Plaintiffs

V.

TRINITY INDUSTRIES, INC.,

Defendant

JUDGMENT IN A CIVIL CASE

☒ **Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict upon answers to special interrogatories.

* * *

IT IS ORDERED AND ADJUDGED

That judgment be entered in favor of the defendant, Trinity Industries, Inc.

Judgment is hereby entered in accordance with the above verdict.

Appendix A

8/15/96
Date

s/ D. Brooks Smith
D. BROOKS SMITH
U.S. District Judge

Appendix A

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Civil Action No. 92-587J

JOHNSTOWN AMERICA CORPORATION, and JAC PATENT CORPORATION,

Plaintiffs,

vs.

TRINITY INDUSTRIES, INC.,

Defendant.

VERDICT SLIP

AND NOW, this 15TH day of August, 1996, we the jury empaneled in this matter, return the following verdict:

1. Do you find that Johnstown America has proven by a preponderance of the evidence that Trinity's Aluminator II car infringes the '097 Patent under the doctrine of equivalents?

Yes_____ No___✓___

(Continue to question 2.)

2. Do you find that Trinity has proven by clear and convincing evidence that the '097 Patent is invalid?

Yes_____ No___✓___

Appendix A

(If you answered either "no" to question 1 or "yes" to question 2, skip questions 3 through 6; otherwise, go to question 3.)

* * *

1. s/ Frank V. Jovenall
   Foreperson
2. s/ Cathleen J. Senko
3. s/ Heidi J. Miller
4. s/ Kathie J. Amos
5. s/ Brenda S. Boehme
6. s/ Richard S. Christner
7. s/ Nicholas C. Hunter
8. s/ Ruth Simms
9. s/ Mary E. Pitzer
10. s/ Sharon L. White

APPENDIX B — TRINITY'S NOTICE OF APPEAL FILED OCTOBER 18, 1996

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA
JOHNSTOWN DIVISION

CIVIL ACTION NO. 92-587J

JOHNSTOWN AMERICA CORPORATION, and JAC PATENT CORPORATION

Plaintiffs,

vs.

TRINITY INDUSTRIES, INC.,

Defendant.

TRINITY'S NOTICE OF APPEAL

Notice is hereby given that Trinity Industries, Inc., defendant in the above-named case, hereby appeals to the United States Court of Appeals for the Federal Circuit from:

- the Order made by this Court denying Trinity's jury instructions (docket no. 138) related to misjoinder of inventors and the submission of the inventorship issue to the jury as reflected in the record at R. (8-13-96) at 173-74 and in Court Ex. 2 (docket no. 177); and

- the Orders denying application or submission of the doctrine of file wrapper estoppel, and specifically the Order entered September 2, 1994 (docket no. 71), the denial Trinity's Motion for Directed Verdict (docket no. 173) made in the

record at R. (8/5/96) at 230 and R. (8/6/96) at 256, the denial of Trinity's motion for judgment as a matter of law made in the record at R. (8/12/96) at 130-31, and the denial of Trinity's jury instructions on file wrapper estoppel as referenced in the record at R. (8/12/95) at 131-77; R. (8/13/96) at 2-38 and 171-74; and Court Ex. 2 (docket no. 177).

Respectfully submitted this 17th day of October, 1996.

s/ Robert H. Johnston, III
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ATTORNEYS FOR DEFENDANT TRINITY INDUSTRIES, INC.

Appendix B

CERTIFICATE OF SERVICE

I hereby certify that on the 17th of October, 1996, a true and correct copy of this instrument was served by Federal Express upon Raymond G. Hasley, Rose, Schmidt, Hasley & DiSalle, P.C., 900 Oliver Building, Pittsburgh, Pennsylvania, 15222-5369.

s/ Robert H. Johnston, III
Robert H. Johnston III

APPENDIX C — TRINITY'S MOTION TO DISMISS ITS CROSS APPEAL DATED MARCH 4, 1997

IN THE
United States Court of Appeals
FOR THE FEDERAL CIRCUIT

No. 97-1070, -1071

JOHNSTOWN AMERICA CORPORATION AND JAC PATENT CORPORATION,

Plaintiffs-Appellants,

v.

TRINITY INDUSTRIES, INC.,

Defendant-Cross-Appellant.

TRINITY'S MOTION TO DISMISS ITS CROSS APPEAL

Defendant-Appellee, Trinity Industries, Inc., moves to dismiss Trinity's cross-appeal (97-1071). Trinity now views the issues raised in its cross appeal as moot in view of the favorable jury verdict and judgment entered in favor of Trinity.

Therefore, Trinity requests that this motion be granted and its cross appeal dismissed.

Respectfully submitted this 4th day of March, 1997.

Appendix C

By: s/ Robert H. Johnston, III
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ATTORNEYS FOR
DEFENDANT-CROSS-APPELLANT,
TRINITY INDUSTRIES, INC.

Appendix C

CERTIFICATE OF CONFERENCE

Pursuant to Fed. Cir. R. 27(a)(5), on February 24, 1997, counsel for Defendant-Cross-Appellant, Trinity, conferred with Brian W. Ashbaugh, counsel for Plaintiff-Appellants, Johnstown America Corporation and JAC Patent Corp., to obtain consent or a statement of opposition with respect to this Motion. Mr. Ashbaugh would neither express consent nor opposition.

s/ Robert H. Johnston, III
Robert H. Johnston III
ATTORNEY FOR
DEFENDANT-CROSS-APPELLANT,
TRINITY INDUSTRIES, INC.

Appendix C

CERTIFICATE OF INTEREST

Pursuant to Rule 47.4 of the Federal Circuit Rules, the undersigned counsel for Defendant-Cross-Appellant, Trinity Industries, Inc., certifies:

1. The full name of every party represented on this appeal by me is Trinity Industries, Inc.

2. Trinity Industries, Inc. is the real party in interest in this case.

3. Pursuant to Federal Rule of Appellate Procedure 26.1, the only parent company, subsidiary or affiliate of Trinity Industries, Inc. that has issued shares to the public is Halter Marine Group, Inc.

4. The names of all law firms whose partners or associates have appeared for Trinity Industries, Inc. in the trial court or are expected to appear for it in this court are: Larry D. Carlson, Robert M. Chiaviello, Jr., Robert H. Johnston III, Jerry W. Mills, Baker & Botts, L.L.P.; Frederick N. Egler, Sr., Egler, Garrett & Egler; and Dennis M. McGlynn, R. Thomas Strayer Law Offices.

Date: March 4, 1997

s/ Robert H. Johnston, III
Robert H. Johnston III
ATTORNEY FOR
DEFENDANT-CROSS-APPELLANT,
TRINITY INDUSTRIES, INC.

APPENDIX D — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT FILED MARCH 19, 1997

United States Court of Appeals for the Federal Circuit

97-1070, -1071

JOHNSTOWN AMERICA CORPORATION and JAC PATENT CORPORATION,

Plaintiffs-Appellants,

v.

TRINITY INDUSTRIES, INC.,

Defendants-Appellees.

ON MOTION

ORDER

Upon consideration of the unopposed motion of Trinity Industries, Inc. to voluntarily dismiss its cross appeal.

IT IS ORDERED THAT:

(1) Trinity's motion is granted and appeal no. 97-1071 is dismissed.

(2) Copies of this order, and the briefs as filed, will be transmitted to the merits panel assigned to hear 97-1070.

Appendix D

FOR THE COURT

3/19/97	s/ Jan Horbaly
Date	Jan Horbaly
	Clerk

cc: Raymond G. Hasley, Esq.
Larry D. Carlson, Esq.

ISSUED AS A MANDATE AS TO 97-1071 ONLY: MAR 19 1997

APPENDIX E — EXCERPT OF APPELLEE TRINITY INDUSTRIES, INC.'S PETITION FOR REHEARING AND SUGGESTION FOR REHEARING IN BANC

[commencing at page 8]

This Court's reinterpretation of the parallelism limitation necessitates that Trinity be granted a new trial. Trinity attacked the validity of the '097 Patent with evidence and arguments carefully crafted after consideration of — and based upon — the district court's construction of the Patent. If the district court's underlying construction of the Patent was wrong, then the verdict and the entire decision-making process to verdict (e.g., evidence, arguments, counter arguments, jury instructions, deliberations, etc.) was a non sequitur. This Court's reinterpretation of the '097 Patent, which has the effect of substantially broadening the scope of the claims, correspondingly renders the Patent much more vulnerable to a renewed and refocused invalidity challenge by Trinity. Given a new trial, and with the opportunity to present evidence, Trinity can persuade a jury that the newly construed, and substantially [9] broadened, claims of the '097 Patent are invalid under 35 U.S.C. §§ 102 and 103. Fundamental fairness requires that Trinity be granted the opportunity to (1) challenge the validity of the Patent in light of the new construction of the parallelism limitation, (2) marshall evidence and arguments tailored to the new construction of the claims, and (3) have a jury determine the validity of the Patent in light of that new construction and (competing) evidence. Without a fair chance to meet fully this Court's newly declared interpretation with evidence proving the invalidity of the '097 Patent, Trinity will be denied its Constitutional right to a proper day in court.

* * *